Remarks

Claims 1-21 and 30-32 are in the application, of which claims 1, 7, 13, 15, and 32 are in independent form. Claims 1, 7, 10, 13, and 15 are amended to clarify the invention. Claim 32 is new. No new matter is added via the claim amendments.

Claim Rejections – 35 U.S.C. § 101

Claims 7-11 stand rejected for being directed to non-statutory subject matter. Applicants respectfully request reconsideration in light of the amendments to claim 7 and based on the following remarks.

Contrary to the allegation in the OA at page 23, the fact that method steps could be performed manually does not remove a method from the ambit of statutory subject matter. *See, for example, In re Bilski*, 545 F.3d 943, 950 (Fed. Cir. 2008) (not rejecting or making any statement regarding the Board of Patent Appeals and Interferences' assertion that a method reciting manually performed steps is clearly a statutory transformation when a physical transformation occurs). For example, manually marking-up a document would create a physical transformation and thus be statutory subject matter under current federal law.

Many of the method steps recited in claim 7 result in physical transformations or are not capable of mental execution. For example, the step of "marking-up an unmarked-up document according to a schema, ..." cannot be performed mentally as it is not possible for a person to think about marking-up either an electronic or paper unmarked-up document and have such an unmarked-up document become marked-up. And, if the step is performed manually it creates a physical transformation as noted above. Likewise, "generating a user-requested document in electronic form ..." cannot be performed mentally, and if performed manually would create a physical transformation, for example, on an electronic display screen or printed on paper or other suitable medium.

Additionally, claim 7 is amended to recite "receiving a user selection of one of a plurality of stored formats <u>over an electronic network</u>," and that the generated user-requested document is "in electronic form." Support for such amendments is found at least at page 4, line 35 and page 6, lines 14-15. Claim 7, as amended, is thus tied to an "electronic network" and cannot be performed purely mentally or manually. Similar language is contained in claim

15, which the Office has not rejected under 35 U.S.C. § 101. The same standard should therefore be applied to claim 7 to find that it is drawn to statutory subject matter.

Claim 7 thus meets the requirements for statutory subject matter under 35 U.S.C. § 101 as interpreted by current federal case law. Applicants respectfully request the Office to reconsider and withdraw the statutory subject matter rejection.

Claim Rejections – 35 U.S.C. § 102

Claims 1-4, 7-10, 30, and 31 stand rejected as anticipated under 35 U.S.C. § 102(e) by U.S. Patent No. 7,035,837 of Reulein et al. Applicants respectfully request reconsideration and withdrawal of such rejections based on the amendments to the claims and the following arguments.

Before embarking on a detailed rebuttal of the Examiner's rejection, it may be useful to mention the contrasting philosophies of Reulein and exemplary embodiments covered by the claimed invention. Reulein is concerned with efficient assembly of personalised documents from a database of content "components". Examples are insurance policies and legal contracts, which have some personal elements and also passages of "boilerplate" text. If a change is to be made to the "boilerplate", it need only be made once, to the corresponding component in the database. The change will then flow through to all generated documents using that component. This efficiency of maintenance and editing of common content among personalised documents is the motivation behind Reulein's invention.

One purpose of the present invention is diametrically different. The generated documents are personalised as regards visual format, but the content is sacrosanct and must be preserved from end to end. An example usage is by a person who has suffered brain injury and consequently has trouble "tracking" their eye along a row of text in a conventionally printed book. If that person wants to read, say, Great Expectations by Charles Dickens, they can request that work in a format that alleviates their disability, e.g., by increasing the font size and the spacing between lines. However, the present invention does not alter the content of the work, as that would defeat the purpose of supplying Great Expectations and not some other book, as well as raising copyright issues.

Claims 1 and 7 have been amended to more clearly reflect this stark difference in philosophies. In particular, Reulein does not disclose all the particularly claimed limitations of claims 1 and 7 as amended.

Firstly, in the note on page 2, the examiner construes the claimed "unmarked-up document" to mean the "output document". This construction is inconsistent with the specification. For example, page 3 line 34 "A load / markup process 14 allows the upload and mark-up of documents" and page 4 line 4 "The application of a schema makes the structural information implicit in a document become 'explicit' make clear that the document starts out unmarked-up, then a process 14 marks it up. In other words the "unmarked-up" document is clearly the input to the whole claimed system and method, not the output thereof. Using the example provided above, a copy of Great Expectations as originally published corresponds to an "unmarked-up" document. A marked-up document using a mark-up schema may include two types of formatting information (i) formatting for addressing a reading disability and (ii) formatting corresponding to the layout of the originally published version of Great Expectations (implicit structural information), such as headings and paragraph breaks. A user-requested document may include a copy of Great Expectations printed in a format that alleviates the disability of a reader with a brain injury where the printed document also contains the original layout of the originally published version of Great Expectations.

The examiner's perverse construction of "unmarked-up document" allows Reulein's final output document (e.g. a PDF document) to be read onto "unmarked-up document": "Reulein disclosed a repository for storing XML document component[s] ... which can be assembled into a document" (page 4 line 5 of the Office Action). The examiner goes on to assert that it is "well-known in the art" that XML files "contain explicit structural information corresponding to implicit structural information contained in a corresponding unmarked-up / output document". This may be so for a process such as Reulein's that renders an XML document into an output document, but is not so for the claimed system and method, which starts by converting an unmarked-up document to a marked-up (XML) document, the reverse of Reulein's process. The proposed amendments to claims 1 and 7 are intended to make this direction of processing unambiguous.

In the rejection of claim 7, the examiner notes (page 6 line 4) that "Reulein also disclose[s] the user editing / marking up an XML document / component". The examiner is

therefore reading Reulein's "editing" onto the claimed step of "marking-up" a document. However, in claim 7 as amended, the claimed "marking-up" is "according to a schema", unlike Reulein's "editing". Also, the examiner has not addressed our argument in the previous response (filed 17 December 2009) that Reulein's document repository 106 is not "a document store for storing formats". Rather, 106 stores documents and components. Reulein's documents are generated "in a variety of industry standard formats including postscript, PDF, HTML, and metacode" (col. 4 lines 38 to 40), none of which are "formats" stored in the document repository 106. In contrast, with respect to claim 7 one of the stored "formats" is used by the claimed "document production processor" to generate a user- requested document.

Regarding new claim 32, in addition to the above-noted differences, Reulein does not, contrary to the examiner's assertion regarding claim 10, disclose that "said user-selected format includes a set of rules having parameters capable of user replacement". In rejecting claim 7, the Examiner identified the claimed "formats" with Reulein's "a variety of industry standard formats including postscript, PDF, HTML, and metacode" (col. 4 lines 38 to 40). However, in rejecting claim 10, the Examiner cites passages of Reulein describing user customisation of the assembly process (e.g. col. 5 lines 1 to 7), which he summarises as "deletion or insertion of variable text and variable data". Reulein's assembly process is distinct from Reulein's publication process, which is where the "selected format" (e.g. PDF) is invoked to produce the "published document" (see e.g. col. 6 lines 46 to 48). Therefore, it is inconsistent to read the user customisation of the assembly process onto the claimed user-editability of the formats, which are only invoked at the publication stage. There is no disclosure in Reulein that a user may "replace parameters" in the formats, i.e. the "industry standard formats including postscript, PDF, HTML, and metacode", as recited in new claim 32.

For the above reasons, Reulein et al. does not disclose or suggest the limitations recited in amended independent claim 1 or 7. Applicants respectfully request the Office to reconsider and withdraw the rejection of claims 1 and 7.

Claims 2-4, 30, and 31 depend from claim 1 and recite additional unique limitations. For at least these reasons, applicants respectfully request the Office to reconsider and withdraw the rejection of claims 2-4, 30, and 31.

Claims 8-10 depend from claim 7 and recite additional unique limitations. For at least these reasons, applicants respectfully request the Office to reconsider and withdraw the rejection of claims 8-10.

Claim Rejections – 35 U.S.C. § 103

Claims 5 and 11 stand rejected as obvious under 35 U.S.C. § 103 over Reulein et al. in view of U.S. Patent Pub. No. 2002/0065852 of Hendrickson et al. Applicants respectfully request reconsideration and withdrawal of such rejections based on the amendments to the claims and the following arguments.

Claim 5 depends from claim 1 and claim 11 depends from claim 7. As discussed above, Reulein et al. does not disclose all of the limitations recited in independent claims 1 or 7. Hendrickson et al. does not make up the deficiencies noted above with respect to Reulein et al.

Additionally, Hendrickson et al. does not disclose or suggest one or more of the formats recited in claims 5 and 11. Hendrickson et al. merely discloses changing resume styles, *i.e.*, layouts, and making changes such as font size, font type, or line spacing. *See* Hendrickson et al. at ¶ 27. Such changes are a far cry from the special formatting styles recited in claims 5 and 11 (*e.g.*, variable paragraph or word shapes, variable paragraph spacing, variable character height, etc.), which are designed to assist persons with vision or reading disabilities read selected documents.

For the above reasons, Reulein et al. in view of Hendrickson et al. does not make claims 5 or 11 obvious. Applicants respectfully request the Office to reconsider and withdraw the rejection of claims 5 and 11.

Claims 6 and 12 stand rejected as obvious under 35 U.S.C. § 103 over Reulein et al. in view of U.S. Patent Pub. No. 2002/0111963 of Gebert et al. Applicants respectfully request reconsideration and withdrawal of such rejections based on the amendments to the claims and the following arguments.

Claim 6 depends from claim 1 and claim 12 depends from claim 7. As discussed above, Reulein et al. does not disclose all of the limitations recited in independent claims 1 or

7. Gebert et al. does not make up the deficiencies noted above with respect to Reulein et al. For at least this reason, applicants respectfully request the Office to reconsider and withdraw the rejection of claims 6 and 12.

Claims 13-21 stand rejected as obvious under 35 U.S.C. § 103 over Reulein et al. in view of U.S. Patent Pub. No. 2002/0019786 of Gonzalez et al. Applicants respectfully request reconsideration and withdrawal of such rejections based on the amendments to the claims and the following arguments.

Regarding independent claims 13 and 15, amended claim 13 recites "... each marked-up document having been obtained by marking up an unmarked-up document according to one or more mark-up schemas, and each marked-up document comprising explicit structural information corresponding to implicit structural information contained in said unmarked-up document, a document format store for storing formats, ..." In a similar vein, amended claim 15 recites "...each marked-up document having explicit structural information corresponding to implicit structural information contained in a corresponding one of said unmarked-up documents; ..." For the reasons discussed above with respect to similar limitations in claims 1 and 7, Reulein et al. does not disclose or suggest the quoted limitations in claims 13 and 15. Gonzalez et al. does not make up the deficiencies noted above with respect to Reulein et al.

Applicants therefore respectfully request the Office to reconsider and withdraw the rejection of claims 13 and 15.

Claim 14 depends from claim 13. As discussed above, Reulein et al. in view of Gonzales et al. does not disclose or make obvious all of the limitations recited in independent claim 13. For at least this reason, applicants respectfully request the Office to reconsider and withdraw the rejection of claim 14.

Claims 16-21 depend from claim 15. As discussed above, Reulein et al. in view of Gonzales et al. does not disclose or make obvious all of the limitations recited in independent claim 15. For at least this reason, applicants respectfully request the Office to reconsider and withdraw the rejection of claims 16-21.

Applicants believe the application is in condition for allowance and respectfully request the same.

The Commissioner is hereby authorized to charge any fees which may be required in connection with filing of this paper, or credit overpayment, to Deposit Account No. 19-4455.

Respectfully submitted,

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